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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steve Grove

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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY

P.O. BOX 2938

MINNEAPOLIS, MN 55402

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3695

NOTIFICATION DATE

DELIVERY MODE

04/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

Office Action Summary	Application No. 10/023,583	Applicant(s) GROVE ET AL.	
	Examiner SIEGFRIED E. CHENCINSKI	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/21/08, 12/22/08 & 4/06/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 46-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 46 recites a process comprising the steps of storing, accepting, searching, generating and communicating. Claims 47-54 are rejected because of their dependence on claim 46. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Further, in *In re Bilski* (October, 2008), the Federal Circuit Court declared that each essential method step be positively tied to a statutory class. None of the limitations in independent claim 46 meet this requirement, as each could be performed by a non-statutory means such as by hand, telephone conversation and various other human interventions. Further, the claim has no useful or concrete end result, since the ending step, a communications step, fails to result in a transaction, which is what the preamble calls for.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 35-47, 49-51 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito et al. (US Patent 6,587,838 B1, hereafter Esposito) in view of Kopelman et al. (US Patent 7,373,317 B1, hereafter Kopelman) and Offutt Jr. et al. (US PreGrant Publication 2002/0184059 A1, hereafter Offutt).

Re. Claims 36-47 & 49-56, Esposito discloses a method, system and medium to enable users to interact with the system over heterogeneous network environments such as a packet switched network such as the Internet and a wireless network such as a plurality of pagers to learn about and express interest in products and services stored in a database (Abstract, ll. 1-6, 10-16). Esposito facilitates a transaction by a network-based transaction facility, the method comprising:

- storing in a database maintained by the network-based transaction facility a listing of a plurality of items being offered for sale by a seller in a virtual store of the seller (Abstract, ll. 10-12; virtual stores are implicit in electronic representations but not explicitly cited as such by Esposito), wherein the items offered for sale are associated with a plurality of transaction types a fixed price-setting process (Col. 5, l. 62);

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- accepting a search criteria, from a buyer, to retrieve a specific item offered for sale by the seller and that meets the search criteria Abstract, ll. 14-16; Fig. 4 - 410);
- searching the database to determine if any items being offered for sale by the seller meet the search criteria (abstract, ll. 10-12; Col. 2, ll. 13-16), generating a commingled list of located items offered for sale by the seller that meet the search criteria (col. 2, ll. 13-16. Commingling in the list is implicit as long as there are a plurality of items); and
- communicating the generated commingled list to the buyer (Fig. 4 – 412; Col. 2, ll. 13-20).

Esposito does not explicitly disclose an auction price-setting process.

However, Esposito discloses two articles regarding auctions, entitled "GM Buying into Online Auctions" and "Honda to Start Internet Used Car Auctions" (OTHER PUBLICATIONS, p. 2, col. 2, ll. 34-35, 41-42). Further, Kopelman discloses an auction price-setting process (Col. 1, ll. 50-51). The servers in the computers systems and the storage media are implicit in Esposito.

Also, Offutt discloses virtual stores (p. 1, [0008], l. 6).

Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the art of Esposito and Kopelman for the purpose of establishing a method, system and medium for facilitating a transaction by a network-based transaction facility, motivated by a desire to provide a method for facilitating pricing and sales of goods (Kopelman, Col. 2, ll. 46-48).

Re. Claim 47, Esposito discloses accepting a search request from a buyer to view certain items according to certain criteria, generating list of items from the commingled list, and displaying the list of items to the buyer (see the rejection of claim 46). Esposito also discloses the displaying of search results to a buyer (Fig's 5-7). Esposito does not explicitly disclose auction items being offered. However, Kopelman discloses auction items. Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Esposito and Kopelman for

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the purpose of responding to a search request limited to auction items and displaying those items to the buyer, motivated by a desire to provide a method for facilitating pricing and sales of goods (Kopelman, Col. 2, ll. 46-48).

Re. Claim 49, Esposito discloses accepting a search request from the buyer to view only those items from the commingled list that include a fixed price purchase option; generate a fixed price list of items from the commingled list, the fixed price list including items that have a fixed price purchase option; and display the fixed price list of items to the buyer (Fixed price – Col. 5, l. 62. See the rejection of claim 46 for the balance of these limitations.).

Re. Claim 50, Esposito discloses accepting a request from the buyer to sort the commingled list by a specific criteria, wherein the specific criteria includes one of a price, a specific transaction type, and an end time; generating a sorted list, the sorted list sorted based on the specific criteria; and communicating the sorted list to the buyer (The disclosures by Esposito are cited in the above rejections of claims 46-49. Esposito also discloses real time criteria in responding to buyer requests. It would have been obvious to the ordinary practitioner to include an end time in responding to a buyer's request for a sorted list which includes price, transaction type and end time.

Re. Claim 51, Esposito discloses the selection of merchants (equivalent to stores) for buyer selection which are stored in the database (Fig. 4-420, a plurality of merchants), using an interface storing in the database a stores portion including a listing of stores available for buyer selection; providing an interface which allow the buyer to indicate a selection from the listing of stores (Fig. 4, 422); and receiving from the buyer a selection including an indication of a selection from the listing of stores (Fig. 4, 424).

Re. Claims 37-45, Esposito suggests, implies and makes obvious the following limitations for implementing method claims 46-54 because Esposito discloses network connected computer systems for implementing a network based transaction facility (Abstract; Fig's 1-7; Col. 2, l. 60 – Col. 7, l. 36):

Re. Claim 37, a page server operable to deliver web pages;
a picture server operable to dynamically deliver images to be displayed within

web pages;

a listing server operable to facilitate category-based browsing of one or more

items being offered for sale on the network-based transaction facility; and

a search server operable to receive search requests and facilitate keyword-based browsing of the one or more items being offered for sale on the network-based transaction facility.

Re. Claim 38, wherein the at least one back-end server includes a search index server coupled to a search index server database.

Re. Claim 39, wherein the at least one back-end server includes a credit card database server coupled to a credit card server database.

Re. Claim 40, wherein the database includes a database engine server coupled to at least one engine server database including a user table, the user table containing a respective record for each of a plurality of users of the network-based transaction facility.

Re. Claim 41, wherein each of the plurality of users is a seller, a buyer, or both a seller and a buyer within the network-based transaction facility.

Re. Claim 42, wherein the engine server database includes an item table that is linked to the user table and that includes a sellers items table and a bidder items table, wherein each link between the item table and the user table indicates whether a user listed in the user table is a seller or a buyer with respect to one or more items for which records are included within the items table.

Re. Claim 43, wherein the item table includes a number of fields for each of a plurality of records that describe an item offered for sale via the network-based transaction facility.

Re. Claim 44, wherein at least one of the number of fields includes a sale type field operable to record the type of item that indicates a price-setting process by which a price for the item relevant to the record associated with the item being offered for sale is established.

Re. Claim 45, wherein the plurality of front-end serves act in combination as a

display engine to facilitate the display at the at least one client machine of the commingled list of items generated by the network-based transaction facility. The ordinary practitioner of the art would have seen these system features as obvious for implementing method claims 46-54 because the practitioner would have been familiar with the capabilities of such computer systems such as servers, web pages, browsing, search indexes, networks, databases, user tables, transaction facilities, number fields and display engines. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the art of Esposito and Kopelman for the purpose of establishing a method, system and medium for facilitating a transaction by a network-based transaction facility, motivated by a desire to provide a method for facilitating pricing and sales of goods (Kopelman, Col. 2, ll. 46-48).

Re. claims 52-54 & 56, the disclosures of Esposito are cited in the rejections of claims 46-51 above. Neither Esposito nor Kopelman explicitly disclose virtual stores. However, Offutt discloses virtual stores for online shoppers (p. 1, [0008], l. 6). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Esposito, Kopelman and Offutt in order to formulate the following features:

Re. Claim 52, a selection from a listing of stores provided according to a category; and providing an interface displaying a list of seller's virtual stores based on the selected category.

Re. Claim 53, receiving from the buyer a selection indicating a chooses one of seller's virtual stores from the listing of stores.

Re. Claim 54, indicating the chosen one of the seller's virtual stores, performing a look-up operation on an items table within the database to obtain a title and details including a transaction type associated with each of one or more items available in the chosen one of the seller's virtual stores.

Re. Claim 56, wherein the database includes items offered for sale in at least one seller's virtual store that offers for sale both at least one item for sale using

an auction-type price setting process and at least one item offered for sale using a fixed price setting process.

The practitioner's motivation would have been a desire to provide a method for facilitating pricing and sales of goods (Kopelman, Col. 2, ll. 46-48).

3. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito in view of Kopelman and Offutt as applied to claim 46 above, and further in view of O'Neill et al. (US Patent 5,987,440, hereafter O'Neil).

Re. Claim 48, neither Esposito nor Kopelman explicitly disclose transaction types which include items for sale using a hybrid auction/fixed price-setting. However, O'Neil discloses a hybrid auction/fixed price-setting (Col. 34, ll. 26-33, Col. 67, ll. 64-65).

Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the art of Esposito, Kopelman and O'Neil for the purpose of establishing a method, system and medium for facilitating a transaction by a network-based transaction facility including a hybrid auction/fixed price-setting, motivated by a desire to provide a method for facilitating pricing and sales of goods (Kopelman, Col. 2, ll. 46-48).

Response to Arguments

4. Applicant's arguments filed December 22, 2008 regarding claims 36-56 have been considered but they are moot in view of the new grounds of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Kyle, can be reached on (571) 272-6746.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or Faxed to (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

April 13, 2009

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 3695